

REMARKS

Claims 27-49 are pending in the application. Applicants thank the Examiner for the teleconference of September 13, 2006 with Robert Hayden (42,645), Karen Kaufman (57,239) and Ajit Shah (Inventor) to assist Applicants' understanding of the Examiner's position on the prior art, discussed below. Although Applicants discussed with the Examiner the possibility of filing an RCE, upon further consideration of the teachings of the prior art, Applicants do not believe further action will be warranted and submit these remarks. Reconsideration of claims 27-49 is therefore respectfully requested.

Claim Rejections

Claims 27-49 have been rejected under 35 U.S.C. §102(e) as being anticipated by Liu (US 6,216,131). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants contend that the interpretations given by the Examiner to the limitations in claim 27 are unreasonably broad in view of the specification. Further, when these terms are properly construed, Liu does not anticipate claim 27 and therefore claim 27 is allowable.

Independent claim 27 is directed to an information exchange system comprising a database for storing at least one field of personal information. The system also comprises "an engine configured to determine an identity of a first party to be provided personal information, determine whether a selected field of the personal information of a second party can be provided to the first party, and provide the selected field of personal information of the second party to the first party." Applicants assert that Liu cannot anticipate claim 27 because Liu does not, at least, teach an engine configured to determine an identity of a first party or the information of a second party. As such, the system described in Liu can not further determine whether a selected field of the personal information of a second party can be provided to the first party or provide the selected field of the personal information of the second party to the first party.

Applicants note MPEP §2111 which provides that "[d]uring patent examination, the pending claims must be 'given their broadest *reasonable* interpretation consistent

with the specification.’ *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000, emphasis added).” This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, ___F.3d___, 75 USPQ2d 1321 (Fed. Cir. 2005) (en banc).

If extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant’s use of the terms. *Brookhill-Wilk I*, 334 F. 3d at 1300, 67 USPQ2d at 1137; see also *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) (“Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.”).

Based on the teleconference of September 13, 2006, it is Applicants’ understanding that the Examiner views the software for synchronization described in Liu as the engine of claim 27. Applicants further understand that the Examiner views the REX handheld device 154 described in Liu as the “first party” referred to in claim 27. Further, Applicants understand that the Examiner views the computer system 100 described in Liu as the “second party” of claim 27.

Applicants assert that Liu does not teach “an engine configured to **determine** an identity of a first party” as recited in claim 27. If extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant’s use of the terms. *Brookhill-Wilk I*, 334 F. 3d at 1300, 67 USPQ2d at 1137. Based on the disclosures within the specification, the term “determine” is properly construed according to the definition, “To establish or ascertain definitely, as after consideration, investigation, or calculation.” determine. (2.d.). *The American Heritage*®

Dictionary of the English Language, Fourth Edition. Retrieved September 25, 2006, from Dictionary.com website: <http://dictionary.reference.com/browse/determine>.

According to the specification as filed, the engine determines the identity of the first party by “verify[ing] that the user logging in to the system 102 is a registered user and...retriev[ing] the internal account ID of the user” (page 8, lines 9-11). Accordingly, after the engine *investigates* that the user is registered, the engine *ascertains* the internal account identifier of the user. In another example, the specification discloses maintaining “[account] information [that] includes, but is not limited to, whether a user is a business or individual user, their internal account ID and password, the last time they logged into the system 102, whether their registration is still active, etc.” (page 9, lines 4-7). As the engine is configured to store information such as a login name and a password associated with the user, the engine uses information provided by the user to ascertain the identity of the user based on whether the information matches the information stored in the account manager 152.

In view of the proper construction of “determine,” the synchronization software of Liu does not determine the identity of the organizer 154. To synchronize information in Liu, an “opening Wizard panel 300a ask[s] the user to enter a user name...for storing configuration information” (Col. 5, lines 37-39). As shown in FIG. 3A of Liu, a user selects a user name from a menu. Rather than determining an identity of the REX 154, Liu merely provides a list of known user names for a user to select amongst. Thus, the synchronization software of Liu does not consider, investigate, or calculate to ascertain the username. Therefore, the synchronization software described in Liu does not “determine” the user name of the REX 154.

Further, Liu does not teach “the personal information of a second party” as recited in claim 27. If extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant’s use of the terms. *Brookhill-Wilk 1*, 334 F. 3d at 1300, 67 USPQ2d at 1137. Based on the disclosures within the specification, the term “of” is properly construed according to the definition, “used to indicate possession, connection, or association: the king of France; the property

of the church.” of. (7.d.). *Dictionary.com Unabridged (v 1.0.1)*. Retrieved September 28, 2006, from Dictionary.com website: <http://dictionary.reference.com/browse/of>.

For example, the specification discloses a system that “provides a storage mechanism for registered individual and business users of the system 102 to store information about themselves and/or their business” (page 5, lines 22-24). The specification further illustrates, “personal information of the second party” refers to “individual user’s information includ[ing] name, home and office addresses, home, office, mobile phone, and various other phone numbers, date of birth...” (page 5, lines 25-27). Thus, the information is associated with, or connected to, an individual.

The synchronization software of Liu, however, does not teach “personal information of the second party.” As noted, the Examiner has equated the PC 100 to the second party of claim 27. Liu discloses “a system which allows a user of an information processing device to readily map or translate user information, such as user-supplied contact lists, from one data set on one device into another data set, either on the same device or on another device” (Col. 2, lines 33-36). It is clear, therefore, that the information that is being synchronized in Liu is not associated with, nor connected to, the PC 100. Being “user information,” the information being synchronized is “of” a user, not “of” the PC 100.

For at least the reasons provided above, Liu cannot anticipate the system of claim 27. Applicants therefore request that the Examiner withdraw the rejections of claim 27, and claims 28-34 depending therefrom, under 35 U.S.C. §102(b). Further, the Applicants request that the Examiner withdraw the rejections of claims 35-49 for at least the reasons discussed herein.

Dependent claim 30 is directed to the information exchange system of claim 27 “wherein the engine is configured to receive a message indicating a request **from the first party** for the selected field of the personal information of the second party and to process the message to provide the selected field of the personal information to the first party.” For example, the specification discloses an engine that “provides interfaces to enable users to request information from each other, approve or deny requests for information, and provide authorized information” (page 21, lines 4-6). Thus, the first party receives the request for the information from the second party.

The synchronization software of Liu, however, does not teach “a request from the first party [REX 154] for the selected field of the personal information of the second party [PC 100].” Liu discloses that “[u]pon the **user** selecting the Synchronize button 351, the system performs synchronization between the two devices...” (Col. 7, lines 20-22). As the user rather than the REX 154 selects the synchronization button as referred to by the Examiner, it is clear that the REX 154 does not send requests to the PC 100 in Liu.

Dependent claim 33 is directed to the information exchange system of claim 27 “wherein the engine is configured to receive a **permission** from the second party, to determine whether the selected field can be provided to the first party based on the permission.” Using the intrinsic record to identify which definition is most consistent with applicant’s use of the terms, “permission” is properly construed as “The ability to access (read, write, execute, traverse, etc.) a file or directory.” permission. (1.d.). *The Free On-line Dictionary of Computing*. Retrieved September 28, 2006, from Dictionary.com website: <http://dictionary.reference.com/browse/permission>. For example, in the specification, a database provides “for storage of permissions data describing sharing and accessibility rules related to the fields of information” (page 3, lines 1-2). The permission therefore indicates whether the first party has the ability to access the selected field.

The synchronization software of Liu, however, does not teach “receiv[ing] a **permission** from the second party.” Liu discloses that “[t]he user can simply select the appropriate memo file to synchronize” (Col. 6, lines 30-31). Liu also provides “a mechanism whereby the system automatically detects and sets up mappings for each cardfile that the user selected to synchronize (Col. 6, lines 52-54). In Liu, “[t]he user can override this mapping, as desired” (Col. 6, lines 55-56). Further, Liu discloses that “[u]pon the user selecting the Synchronize button 351, the system performs synchronization between the two devices” (Col. 7, lines 20-22). The system disclosed in Liu is therefore preconfigured with a set of default mappings. The user, rather than the PC 100, is able to change the mappings. As such, Liu does not teach receiving a permission from the second party.

Dependent claim 34 is directed to the information exchange system of claim 27 “wherein the engine is configured to receive a defined period of time that indicates **how**

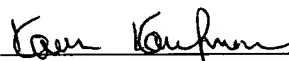
long to share the selected field.” MPEP §2111 provides that “[d]uring patent examination, the pending claims must be ‘given their broadest *reasonable* interpretation consistent with the specification.’ *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000, emphasis added).” For example, the specification discloses, “the system 102...provides the capability for the friend to manage access to personal information by directing the contact manager 148 to share this or any other personal information with the user for a defined period of time only” (page 7, lines 27-30 to page 8, lines 1-2). The specification further illustrates, “[a]fter expiration of this defined period, the user will no longer be able to view the friend’s information” (page 8, lines 2-4). Therefore, the defined period of time is used to determine *whether* the personal information of the second party will be provided to the first party.

The synchronization software of Liu, however, does not teach “receiv[ing] a defined period of time that indicates *how long* to share the selected field.” Liu discloses that “the user can use the drop-down list 27 for each setting to change individual preferences” (Col. 6, lines 33-34). An example recited in Liu of a user preference is “Auto Shut-Off[:] Click the arrow and specify how long desired [*sic*] for the REX card to wait before shutting off automatically” (Col. 6, lines 40-42). It is not clear that setting an auto shut-off time of the REX device 154 prevents the REX device from synchronizing the data after the Auto Shut-Off period has expired. Rather, Applicants submit that an auto shut-off period is typically used as a power-saving mechanism, especially in battery-powered devices. Thus, the auto shut-off period is not a limitation on synchronizing the data but is actually based on power considerations. As such, Liu does not teach receiving a defined period of time that indicates **how long** to share the selected field. The Applicants further request that the Examiner withdraw the rejections of claims 38, 41, 42, 46, and 47 for at least the reasons discussed herein.

All pending claims are allowable and Applicants respectfully request a Notice of Allowance. Should the Examiner have questions, the Applicants' undersigned attorney may be reached at the number provided.

Respectfully submitted,
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